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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,773	12/20/2001	Noriaki Ogishima	217573US2	6918

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

QAYYUM, ZESHAN

ART UNIT	PAPER NUMBER
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3685

NOTIFICATION DATE	DELIVERY MODE
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02/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/022,773	Applicant(s) OGISHIMA, NORIAKI	
	Examiner ZESHAN QAYYUM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 41-50 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 41-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 41 and 42 recites the limitation "said data" in 6. There is insufficient antecedent basis for this limitation in the claim.
4. Claims 43-46 and 47-50 are also rejected as each depends from claim 41 and 42 respectively.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 41 is rejected under 35 U.S.C. 102(e) as being anticipated by Bengtson (US 2001/0037462).**
6. With respect to claim 41, Bengtson discloses: a server, an image forming apparatus couple to a terminal apparatus via a network (See Fig 1) server comprising, an enciphering unit configured to generate an enciphered data by subjecting data to an enciphering process such that the enciphered data is decipherable by said image forming apparatus but is not decipherable by said terminal apparatus when a request for said data is received from said terminal apparatus, and a transmitting unit configured to transmit the enciphered data to said terminal apparatus. See paragraph 0013, 0032 and 0033) terminal apparatus comprising, a relay unit configured to transmit the enciphered data received from said server to said image forming apparatus (See paragraph 0041) image forming apparatus comprising, a deciphering unit configured to decipher the enciphered data received from said terminal apparatus, and a printing unit configured to print deciphered data on a recording medium, wherein said data is transported in an enciphered state on said network and within said terminal apparatus (See paragraph 0013, 0030, 0031, 0041 and 0042).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42 rejected under 35 U.S.C. 103(a) as being unpatentable over

Bengtson (US 2001/0037462) in view of Schneck (US 5933498).

8. With respect to claim 42, Bengtson discloses: a server, an image forming apparatus couple to a terminal apparatus via a network (See Fig 1) server comprising, an enciphering unit configured to generate an enciphered data by subjecting data to an enciphering process such that the enciphered data is decipherable by said image forming apparatus but is not decipherable by said terminal apparatus when a request for said data is received from said terminal apparatus, and a transmitting unit configured to transmit the enciphered data to said terminal apparatus. See paragraph 0013, 0032 and 0033) terminal apparatus comprising, a relay unit configured to transmit the enciphered data received from said server to said image forming apparatus (See paragraph 0041) image forming apparatus comprising, a deciphering unit configured to decipher the enciphered data received from said terminal apparatus, and a printing unit configured to print deciphered data on a recording medium, wherein said data is transported in an enciphered state on said network and within said terminal apparatus (See paragraph 0013, 0030, 0031, 0041 and 0042). Bengtson does not explicitly disclose: a processing part configured to update operating software of said image forming apparatus or renew the operating software using the deciphered data. Schneck

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discloses: a processing part configured to update operating software of said image forming apparatus or renew the operating software using the deciphered data (See column/line 23/5-24/4; column 25, lines 10-40 and column 29, lines 58-63).

Therefore, it would have been obvious to one of the ordinary skill at the time invention was made to modify Bengtson with Schneck updating OS in order to patch security vulnerability of operating system.

9. Claims 43 and 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Bengtson (US 2001/0037462) in view of Perlman (US 6363480).

10. With respect to claims 43 and 46, Bengtson discloses: said server further comprises a requesting unit configured to transmit a request to said terminal apparatus for an enciphering key used for said enciphering process when the request for said data is received from said terminal apparatus (See paragraph 0034 and 0035) terminal apparatus further comprises a second relaying unit configured to transmit the request for said enciphering key to said image forming apparatus when the request for said enciphering key is received from said server, and a key relaying unit configured to transmit said enciphering key received from said image forming apparatus to said server (See paragraph 0035, 0037, 0038, and 0039). image forming apparatus further comprises a key transmitting unit configured to transmit said enciphering key to said terminal apparatus when said enciphering key is requested from said terminal apparatus (See paragraph 0038) Bengtson does not

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explicitly disclose: a key generating unit configured to generate said enciphering key. Perlman discloses generating the enciphering key. The Perlman system operates as follows: a sending party who desires to securely transmit data to a receiving party requests a secret key from said receiving party, the receiving party generates the key and transmits the key to the sending party, who in turn enciphers the data with the key and transmits the enciphered data to the receiving party (abstract; column 3, lines 10- 17; column 6, lines 4-11). Since the key is symmetric, the receiving party retains the key (copy or original) in order to decipher the enciphered data. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Bengtson and Perlman in order to ensure limited access to content.

11. **Claims 47 and 50 rejected under 35 U.S.C. 103(a) as being unpatentable over Bengtson (US 2001/0037462) in view of Schneck (US 5933498) in further view of Perlman (US 6363480).**
12. With respect to claims 47 and 50, Bengtson in view of Schneck discloses all the limitations as described above. Bengtson further discloses: said server further comprises a requesting unit configured to transmit a request to said terminal apparatus for an enciphering key used for said enciphering process when the request for said data is received from said terminal apparatus (See paragraph 0034 and 0035) terminal apparatus further comprises a second relaying unit configured to transmit the request for said enciphering key to said image forming apparatus when

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the request for said enciphering key is received from said server, and a key relaying unit configured to transmit said enciphering key received from said image forming apparatus to said server (See paragraph 0035, 0037, 0038, and 0039). image forming apparatus further comprises a key transmitting unit configured to transmit said enciphering key to said terminal apparatus when said enciphering key is requested from said terminal apparatus (See paragraph 0038) Bengtson does not explicitly disclose: a key generating unit configured to generate said enciphering key. Perlman discloses generating the enciphering key. The Perlman system operates as follows: a sending party who desires to securely transmit data to a receiving party requests a secret key from said receiving party, the receiving party generates the key and transmits the key to the sending party, who in turn enciphers the data with the key and transmits the enciphered data to the receiving party (abstract; column 3, lines 10- 17; column 6, lines 4-11). Since the key is symmetric, the receiving party retains the key (copy or original) in order to decipher the enciphered data. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Bengtson in view of Schneck and Perlman in order to ensure limited access to content.

13. **Claims 44 and 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Bengtson (US 2001/0037462) in view of Perlman (US 6363480) and in further view of Chou (US5337357).**

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14. With respect to claims 44 and 45, Bengtson in view of Perlman discloses all the limitations as described above. Bengtson in view of Perlman does not explicitly disclose: wherein said key generating unit of said image forming apparatus generates information unique to said image forming apparatus as said enciphering key; wherein said key generating unit of said image forming apparatus generates said enciphering key based on information unique to said image forming apparatus and a random variable. Chou discloses a method for generating an encryption key that is unique to the receiving apparatus (See column/line 2/40-3/13). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention was made to combine the teachings of Bengtson, Perlman and Chou in order to prevent a content receiving party from making content accessible to other unauthorized parties.

In addition the “image formatting apparatus generates” is the intended use of image formatting apparatus. Therefore, it has been held While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

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15. **Claims 48 and 49 rejected under 35 U.S.C. 103(a) as being unpatentable over Bengtson (US 2001/0037462) in view of Schneck (US 5933498) in further view of Perlman (US 6363480) and Chou (US 5337357).**
16. With respect to claims 48 and 49, Bengtson in view of Schneck and in further view of Perlman discloses all the limitations as described above. Bengtson in view of Schneck and in further view of Perlman does not explicitly disclose: wherein said key generating unit of said image forming apparatus generates information unique to said image forming apparatus as said enciphering key; wherein said key generating unit of said image forming apparatus generates said enciphering key based on information unique to said image forming apparatus and a random variable. Chou discloses a method for generating an encryption key that is unique to the receiving apparatus (See column/line 2/40-3/13). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention was made to combine the teachings of Bengtson, Perlman and Chou in order to prevent a content receiving party from making content accessible to other unauthorized parties.
- In addition the “image formatting apparatus generates” is the intended use of image formatting apparatus. Therefore, it has been held While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685